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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,384	11/08/2000	James R. Hansen	11333-014001	2155
26161	7590	03/01/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			VU, THONG H	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,384

Applicant(s)

HANSEN, JAMES R.

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-18,21-24,27-39,42-45,48-62 and 65-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-18,21-24,27-39,42-45,48-62 and 65-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/04/1/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-3,6-18,21-24,27-39,42-45,48-62,65-75 and new claims 76-88 are pending. Claims 4,5,19,20,25,26,40,41,46,47,63,64 are canceled.

Response to Amendment

2. Claims 1,15,22,36,43,59 and 68 have been amended. Therefore the Final action is appropriate.

Claim Rejections - 35 USC § 112

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (i.e.: determining if deviation ?).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3,6-18,21-24,27-39,42-45,48-62,65-88 are rejected under the judicially created doctrine of double patenting over claims 1-59 of U. S. Patent No. 6,757,714 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

(‘714) 1. A method performed by a device associated with an apparatus to report a state of the apparatus to a remote computer that cannot directly address the device, the method comprising:

detecting the state of the apparatus, wherein detecting is performed by monitoring variables associated with the apparatus, the monitoring occurring independently of communications from the remote computer;

generating a message that reports the state of the apparatus using a self-describing computer language, wherein generating is performed periodically or in response to a deviation in the state;

sending the message to the remote computer; wherein the deviation is indicative of an error condition in the apparatus, and wherein the error condition comprises one or more variables that deviate from an acceptable value or a predetermined range of acceptable values.

(Application) 1.A method performed by a device associated with an apparatus to report a state of the apparatus to a remote computer that cannot directly address the device the method comprising:

detecting the state of the apparatus wherein detecting is performed by monitoring variables associated with the apparatus;

generating a message that reports the state of the apparatus using a self-describing computer language wherein generating is performed periodically or in response to a deviation in the state; and

sending the message to the remote computer wherein the deviation is indicative of an error condition in the apparatus and wherein the error condition comprises one or more variables that deviate from an acceptable value or a predetermined range of acceptable values.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3,6-18,21-24,27-39,42-45,48-62,65-88 are rejected under 35 U.S.C. § 103 as being unpatentable over Williams [6,292,828 B1] in view of Biffar [6,397,212 B1].

6. As per claim 1, Williams discloses A method performed by a device associated with an apparatus to report a state of the apparatus to a remote computer [Williams, remote wireless network, abstract] that cannot directly address the device the method comprising:

detecting the state of the apparatus wherein detecting is performed by monitoring variables associated with the apparatus [Williams, monitoring devices, abstract; system monitoring mode, col 14 lines 1-38];

generating a message that reports the state of the apparatus (using a self-describing computer language) wherein generating is performed periodically or in response to a deviation in the state [Williams, specific alarm status, col 10 lines 1-67 et seq]; and

sending the message to the remote computer wherein the deviation is indicative of an error condition in the apparatus and wherein the error condition comprises one or more variables that deviate from an acceptable value or a predetermined range of

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acceptable values [Williams, deviation and acceptable levels, col 9 line 37 et seq; col 20 lines 1-12].

However Williams does not detail the apparatus using a self-describing language. A skilled artisan would have motivation to improve the software using on the mobile apparatus and found Biffar's teaching. Biffar discloses a self-learning search engine for the wireless device wherein the maximum deviation could be acceptable [Biffar, PDA, col 7 lines 19-30; XML, col 11 lines 3-12; deviation is acceptable, col 14 lines 5-27]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate

7. As per claim 2, Williams-Biffar disclose the message comprises an electronic mail message [Williams, Email, col 16 lines 30].

8. As per claim 3, Williams-Biffar disclose the message comprises a hypertext transfer protocol command [Biffar, PDA, col 7 lines 19-30; XML, col 11 lines 3-12].

9. As per claim 6, Williams-Biffar disclose detecting the state comprises receiving the state variables from the apparatus.

As per claim 7, Williams-Biffar disclose detecting the state comprises detecting the variables periodically from the apparatus.

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10. As per claim 8, Williams-Biffar disclose detecting the state comprises: obtaining an identifier for the apparatus, and reading the variables state from the apparatus using the identifier.

11. As per claim 9, Williams-Biffar disclose determining the deviation [Williams, analyzed for adherence to deviation from acceptable levels, col 9 lines 65]

12. As per claim 10, Williams-Biffar disclose comparing the state to a previous state of the apparatus [Williams, comparing parameters, col 8 lines 43 et seq].

13. As per claim 11, Williams-Biffar disclose the self-describing computer language comprises extensible Markup Language (XML) [Biffar, PDA, col 7 lines 19-30; XML, col 11 lines 3-12].

14. As per claim 12, Williams-Biffar disclose the message is generated using a predefined template, the message being generated by:

obtaining one or more variables relating to the apparatus [Williams, variable modes, col 9 lines 19; col 10 lines 26]; and

inserting the one or more variables into the template [Williams, embedded features, col 13 lines 64 et seq].

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15. As per claim 13, Williams-Biffar disclose the state of the apparatus is included as part of a body of the message [Williams, Email, col 16 lines 30].

16. As per claim 14, Williams-Biffar disclose the state of the apparatus is included as part of an attachment to the message [Williams, Email, col 16 lines 30].

17. As per claim 77, Williams-Biffar disclose the device is embedded in the apparatus [Williams, embedded features, col 13 lines 64 et seq].

18. As per claim 83, Williams-Biffar disclose the message includes past states of the apparatus [Williams, Email, col 16 lines 30].

19. As per claim 86, Williams-Biffar disclose the message includes a unique identifier that corresponds to the apparatus as inherent feature of message.

20. Claims 15-18,21-24,27-39,42-45,48-62,65-76,78-82,84-88 contain the similar limitations set forth claims 1-14,77,83,86. Therefore claims 15-18,21-24,27-39,42-45,48-62,65-76,78-82,84-88 are rejected for the same rationale set forth in claims 1-14,77,83,86.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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-USP 5,517,491 Nanni discloses the deviation control means detects and adjusts signal values being available or not available [Nanni, col 15 lines 35 et seq].

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

Jack Harvey
JACK HARVEY
EXAMINER